

AGILENT TECHNOLOGIES, INC.  
Legal Department DL429  
Intellectual Property Administration  
P. O. Box 7599  
Loveland, Colorado 80537-0599

ATTORNEY DOCKET NO. 10031531-1

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**APR 20 2006**

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Bill J. Peck

Serial No.: 10/813,331

Examiner: Stephanie Mummert

Filing Date: March 29, 2004

Group Art Unit: 1637

Title: METHOD FOR IN SITU GENERATION OF NUCLEIC ACID ARRAYS

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450

## TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond  
☐ New fee as calculated below ☐ Supplemental Declaration  
☒ No additional fee (Address envelope to "Mail Stop Amendments")  
☐ Other: (Fee \$ \_\_\_\_\_)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 <sup>ST</sup> MONTH 120.00 <input type="checkbox"/>	2 <sup>ND</sup> MONTH 450.00 <input type="checkbox"/>	3 <sup>RD</sup> MONTH 1020.00 <input type="checkbox"/>	4 <sup>TH</sup> MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Bill J. Peck

By

Bret E. Field for Herbert Schulze  
Attorney/Agent for Applicant(s)

Reg. No. 37,620

Date: 04-20-2006

Telephone No. (850) 485-4377

I hereby certify that this paper is being facsimile  
transmitted to the Patent and Trademark Office on  
the date shown below:

Date of facsimile: 04-20-2006

Typed Name: Donna Macedo

Signature:

Rev 06/05 (TransAmd)

3 pgs total

VIA FACSIMILE 571-273-8300		
<b>RESPONSE TO RESTRICTION REQUIREMENT</b>  Address to: Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450	Attorney Docket Confirmation No.	10031531-1 5115
	First Named Inventor	Peck
	Application Number	10/813,331
	Filing Date	March 29, 2004
	Group Art Unit	1637
	Examiner Name	Stephanie Mummert
	Title	Method for In Situ Generation of Nucleic Acid Arrays

Dear Sir:

This communication is responsive to the office communication dated March 24, 2006.

In the above referenced office communication, the Examiner imposed a restriction requirement requiring the election of the claims of:

Group I, i.e., Claims 1-16;  
Group II, i.e., Claims 17, 22-23;  
Group III, i.e., Claims 18-21; or  
Group IV, i.e., Claims 24-27.

for further prosecution in this application.

The Applicants hereby elect Group I with traverse.

The Applicants respectfully urge the Examiner to rejoin the claims of Groups II, III and IV with the elected claims of Group I for examination in this application for the following reasons.

The MPEP allows an Examiner to examine otherwise patentably distinct sets of claims if to so would not impose an undue burden on the Examiner. M.P.E.P. § 8.03 states that:

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**If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.**

In the present case, the claims of Groups II, III and IV relate to the array produced by the Group I claims, methods of using the array, and a device for performing the method of the elected claims.

Accordingly, little, if any, additional searching should be required for the claims of Groups II, III and IV, and therefore the examination of the claims of Groups II, III and IV together with the claims of elected Group I should impose little, if any, additional burden on the Examiner.

As such, examining the claims of Groups II, III and IV and the claims of elected Group I together in the present application clearly does not impose an undue or serious burden on the Examiner. In the absence of such an undue or serious burden, the Examiner is clearly instructed by the MPEP to examine the entire application. Therefore, the Examiner is respectfully requested to rejoin the claims of Groups II and III with the claims of elected Group I and to examine all the claims together in the present application.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: April 20, 2006

By: 

James S. Keddie  
Registration No. 48,920

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